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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91162078
Party	Plaintiff THE UNITED STATES PLAYING CARD COMPANY
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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THE UNITED STATES PLAYING  
CARD COMPANY,

Opposer,

v.

HARBRO, LLC,

Applicant.

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Opposition No.: 91162078

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**OPPOSER'S TRIAL BRIEF**

March 13, 2006

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## **I. Preliminary Statement**

Harbro, LLC, ("Harbro") applied at the U.S. Patent and Trademark Office to register the mark **VEGAS**, in International Class 28 for "playing cards." The United States Playing Card Company ("USPC"), a well known manufacturer of playing cards, believes it will be damaged by Harbro's registration of the VEGAS mark. Therefore, USPC filed a petition to oppose the mark based on the fact that the mark is deceptive under Section 2(a) of the Trademark Act or primarily geographically misdescriptive or descriptive within the meaning of Section 2(e). 15 U.S.C. §1052.

Vegas is the "literal equivalent" of the well known tourist destination Las Vegas, Nevada. Hundreds of news stories in 2005 demonstrate that the public knows Las Vegas, Nevada, as both its full name "Las Vegas" as well as its shorter version "Vegas." Vegas is home to several well-known casinos including the MGM Grand, the Bellagio, the Luxor, the Venetian, Binion's Horseshoe, Mandalay Bay, the Rio, the Flamingo and many others.

USPC sells playing cards to these casinos for use at their card tables. Las Vegas is famous for gambling and legally sanctioned games of chance, often using playing cards, such as Blackjack, Baccarat, Pai Gow Poker, Let it Ride, and others. The city also serves as the host of many world-famous poker tournaments including the World Series of Poker and the World Poker Tour's annual championship. Because card playing is prevalent throughout Las Vegas and is one of the reasons tourists visit Las Vegas, the city is associated with card games like poker and playing cards themselves. Additionally, playing cards themselves are associated with Las Vegas. USPC maintains a warehouse in Las Vegas, and the U.S. operations of a major playing card manufacturer, Gaming Players International (GPI), is headquartered in Las Vegas. There is also a market in retail stores

and on the internet for cancelled cards from Las Vegas casinos. Thus, playing cards are intimately associated with Las Vegas.

Applicant's VEGAS mark is not registerable because the mark is primarily geographically misdescriptive. First, Vegas is a well known geographical destination. Second, Las Vegas is associated with playing cards. Finally, the association of a deck of cards with Las Vegas is a material factor in a consumer's purchasing decision. Applicant's cards are not produced in Vegas nor are they used in Vegas casinos, though a consumer purchasing the cards might think otherwise. Thus, Harbro's mark misdescribes its geographic origin in a way that violates this Board's three part test for geographic misdescriptiveness enumerated in In re California Innovations, Inc., 66 U.S.P.Q.2d 1853, 1857 (Fed. Cir. 2003).

The mark VEGAS as applied to Playing Cards is deceptive and primarily geographically misdescriptive, or primarily geographically descriptive. Therefore, the Board should sustain the opposition and refuse registration of the mark.

## **II. Procedural History**

Harbro, LLC, filed an application to register Vegas for playing cards on May 23, 2003, in Class 28 on the Principal Register. The mark was approved for publication on July 21, 2004, and was published in the Official Gazette on August 10, 2004.

USPC filed an opposition to Harbro's VEGAS application on September 9, 2004. Opposer asserted as grounds (1) the mark was deceptive under 15 U.S.C. § 1052(a); (2) or the mark was primarily geographically descriptive or misdescriptive under 15 U.S.C. § 1052(e). Harbro answered the Notice of Opposition on October 29, 2004. Both parties engaged in discovery thereafter.

Opposer, USPC, took trial testimony between July 1, 2005 and July 31, 2005. Harbro's trial testimony occurred between October 28, 2005 and November 28, 2005. Between December 29, 2005 and January 12, 2006, USPC offered rebuttal evidence and testimony. Opposer submits a Notice of Filing concurrently with its Brief outlining each submission by Opposer to the Board. Depositions and exhibits are submitted to the Board and applicant via U.S. Mail, First Class, due to the large volume of documents submitted.

### **III. Evidence Relied Upon**

#### **A. Opposer's Direct Evidence**

Opposer relies upon the trial testimony of the following witnesses:

1. Kevin Bagger, Las Vegas Convention and Visitor's Authority. Mr. Bagger is the director of internet marketing and research for the Las Vegas Convention and Visitor's Authority (LVCVA). (Bagger at 5). LVCVA is the official marketing organization for Las Vegas and the surrounding communities. (Bagger at 5-6). In his capacity as director of internet marketing, Bagger oversees all web marketing efforts of LVCVA. As an employee with eight-years experience, Bagger is familiar with the efforts the Authority makes to promote travel and tourism to Las Vegas. (Bagger at 5-8).

2. Dan Espenscheid, United States Playing Card. Mr. Espenscheid is the Casino Sales Manager for USPC. (Espenscheid at 5). As Casino Sales Manager, Espenscheid is responsible for USPC contracts supplying playing cards to approximately 85 percent of the casinos in Las Vegas. Espenscheid also manages and supervises USPC's Las Vegas warehouse that stores the playing cards for distribution to Las Vegas casinos. (Espenscheid at 7). Mr. Espenscheid is also familiar with how playing cards are used in the casinos of Las Vegas, (Espenscheid at 12.) and the growth of popularity of poker in Las



Vegas. (Espenscheid at 20). Mr. Espenscheid also testified about the sale and market for used casino cards sold in Vegas gift shops. (Espenscheid at 26).

Opposer also relies upon the following Notice of Reliance filed under Rule 2.122(e):

USPC filed a Notice of Reliance on July 29, 2005 with references to over **630** articles from printed publications from newspapers and magazines available to the public. The Notice of Reliance also includes references to entries in *Merriam-Webster's Geographical Dictionary*, *MSN-Encarta* and *American Heritage Illustrated Encyclopedic Dictionary* and television transcripts. Evidence in this Notice of Reliance proves that Vegas refers to Las Vegas, Nevada, which is a well known geographical location, and perhaps the most popular tourist destination in the United States, that an association exists between Vegas and playing cards, and that a material factor in a consumer's purchasing decision is the association between Vegas and playing cards.

**B. Applicant's Evidence**

Applicant relied upon the testimony of a single witness and four U.S. trademark registrations attached to its Notice of Reliance.

Applicant's witness:

Karl T. Ondersma, Attorney - VanDyke, Gardner, Linn & Burkhart, Applicant's sole witness, is an associate with the law firm of VanDyke, Gardner, Linn & Burkhart. (Ondersma at 4). Mr. Ondersma testified that he purchased Las Vegas themed playing cards at a store in Detroit. Testimony from Mr. Ondersma and Exhibit G to his deposition demonstrate the availability of cancelled casino cards used in Las Vegas casinos to purchasers on the internet.

Applicant's Notice of Reliance filed under Rule 2.122(e):

Applicant's Notice of Reliance filed on November 28, 2005 consists of four U.S. trademark registrations (172,312 registered in 1923; 401,715 registered in 1943; 726,940 registered in 1962 and 1,189,273 registered in 1982), all granted well prior to the enactment of NAFTA, the North American Free Trade Agreement, and the amended Lanham Act. Because these registrations were granted when there was a different standard governing primarily geographically misdescriptive marks, they are not relevant to this proceeding. See, In re California Innovations Inc., 66 U.S.P.Q.2d 1853, 1857 (Fed. Cir. 2003) (Because NAFTA and the amended Lanham Act place an emphasis on actually misleading the public, the PTO may not deny registration now without a showing that the goods-place association made by the consumer is material to the consumer's decision to purchase the goods.).

Additionally, third-party registrations are not evidence that the marks were in use and that the relevant purchasing public is familiar with them. In re Broyhill Furniture Industries Inc., 60 U.S.P.Q.2d 1511 (TTAB 2001) (rejecting argument that third-party registrations were evidence that it was customary in the furniture industry to use geographic names as trademarks for furniture and that these locations were strongly associated with a particular style or motif). Further, the PTO's allowance of other registrations with characteristics similar to Applicant's does not bind the Board to act similarly in this case. In re Nett Designs Inc., 57 U.S.P.Q.2d 1564, 1566, 236 F.3d 1339 (Fed. Cir. 2001).

**C. Opposer's Rebuttal Evidence**

To rebut Applicant's argument that the term VEGAS is not primarily geographic and to rebut Applicant's argument that playing cards are not associated with Las Vegas

because playing cards may be manufactured and purchased in other geographic locations, Opposer produced rebuttal evidence which showed that, indeed, Vegas is primarily geographic and playing cards are associated with Vegas and that fact is material to the purchaser of playing cards.<sup>1</sup>

Opposer relies on the rebuttal testimony of the following witnesses:

1. Joseph A. Robinette, United States Playing Card Company. Mr. Robinette is the General Counsel of USPC. (Robinette at 4). As General Counsel, Mr. Robinette coordinates administrative matters, such as trademark filings; he also reviews and drafts USPC's contracts. Further, Mr. Robinette prosecutes and defends all the litigation in which USPC is involved. (Robinette at 5). USPC approved an advertisement for a promotion run by the Kroger Company for the World Poker Tour, which Mr. Robinette reviewed. (*Id.* at 7). The promotion featured the word "Vegas," contained the front of several playing cards and indicated that the winner of the contest would "Win a Trip to Vegas." (Robinette Dep. Exhibit 2). The reference to "Vegas" was clearly a geographic location and playing cards are clearly associated with Vegas in the advertisement.

2. Kathryn K. Przywara, Attorney - Dinsmore & Shohl, LLP. Ms. Przywara is an Attorney with the law firm of Dinsmore & Shohl LLP. (Przywara at 4). Ms. Przywara testified regarding print outs of webpages she visited.<sup>2</sup> These web pages include the Gamblers General Store and OldVegasChips.com, sites which advertise and sell cancelled

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<sup>1</sup> According to McCarthy, "plaintiff in its rebuttal case may introduce facts and witnesses appropriate to deny, explain or otherwise discredit the facts and witnesses of opponent..." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §20:117 (4<sup>th</sup> ed. 2005).

<sup>2</sup> Print-outs of articles downloaded from the internet are admissible where they are introduced with the testimony of the person who accessed the information on the internet. Raccioppi v. Apogee, Inc., 47 U.S.P.Q.2d 1368 (TTAB 1998). Additionally, web site advertisements are admissible as evidence of the purchasing public's perception. Mid City Bowling Lanes & Sports Palace Inc. v. Don Carter's All Star Lanes-Sunrise Ltd., 1998 U.S. Dist. LEXIS 3297 (E.D. La. Mar. 12, 1998) (Exhibit A).

cards from Las Vegas casinos. (*Id.* at 6 and Przywara Dep. Exhibits 6, 7 and 8). Ms. Przywara also testified that she purchased a charm bracelet with a playing card charm and a key tag containing black jack playing cards from the Las Vegas Centennial website. (Przywara at 8 and Przywara Dep. Exhibits 4 and 5). The evidence demonstrates that playing cards are associated with Vegas, and the association is a material factor in a consumer's purchasing decision.

Opposer also relies upon the following Notice of Reliance filed under Rule 2.122(e):

On January 12, 2006 Opposer filed a second Notice of Reliance, including printed publications, such as articles appearing in newspapers and magazines available to the public. The articles cited rebut Applicant's argument that there is no association between Vegas and playing cards and that consumers will not be deceived. The articles also show that the association is a material factor in the purchase decision.

#### **IV. Statement of the Facts**

The United States Playing Card Company is a manufacturer and distributor of playing cards.<sup>3</sup> (Espenscheid at 6). Harbro is a manufacturer and distributor of products including playing cards. Both companies own U.S. Trademark Registrations for goods including "playing cards" in International Class 28.

On May 23, 2003, Harbro LLC, applied to register the mark VEGAS on the Primary Register. The Application was assigned Serial Number 78/253725. On July 21, 2004, the mark was approved for publication in the Official Gazette, and it appeared in the Gazette on

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<sup>3</sup> A competitor of the applicant has standing to oppose applicant's right of registration. Federal Glass Co. v. Corning Glass Works, 162 U.S.P.Q. 279, 282-83 (TTAB 1969); J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §20:11 (4<sup>th</sup> ed. 2005).

August 10, 2004. The United States Playing Card Company filed a Notice of Opposition on September 9, 2004.

Las Vegas, Nevada, is one of America's premier tourist destinations. (Bagger at 7) (Notice of Reliance Index 2, hereinafter "Index"). Las Vegas bills itself as "the entertainment capital of the world," where visitors can not only view live entertainment in casino showrooms, but also enjoy golf, fine dining, relax in a spa or spend time in a casino. (Bagger at 7-8). Las Vegas is known for its gaming, which includes legal games of chance like slot machines, blackjack, craps and roulette. (*Id.* at 9). These games frequently involve the use of playing cards. (*Id.* at 10).

Las Vegas has a visitors' bureau called the Las Vegas Convention and Visitors' Authority (LVCVA). (*Id.* at 5). This entity spends around **75 to 80 million dollars annually** on its advertising budget. (*Id.* at 10). One of LVCVA's current marketing strategies includes use of the logo "Only Vegas." The logo "Only Vegas" appears on the promotional brochures sent to potential visitors of Las Vegas. (*Id.* at 17, Bagger Dep. Exhibits 27 and 28). The official tourism agency also promotes its city by using the tagline "What Happens in Vegas Stays in Vegas." (Bagger at 17).

There are many well-known large casinos in Las Vegas, Nevada. (Espenscheid at 11). The casinos need a replenishable supply of playing cards in order to conduct games of chance such as black jack. (*Id.* at 12). USPC and other card companies including Gemaco and GPI supply playing cards to the casinos. (Espenscheid at 13. See also, Przywara Dep. Exhibit 2). For security reasons, once the casinos use the cards, they are "cancelled" by a process which marks the deck. Such markings include a cut corner or small hole drilled through the card so the cards cannot be reused without detection.

(Espenscheid at 13). Despite the markings on the cards there is a large market for sale of the marked cards because they have been used at a casino as demonstrated through the existence of a multitude of websites where the cards may be purchased. (See Ondersma Dep. Exhibit 6, Espenscheid Dep. Exhibits 10, 12, 13, 14, 15; Przywara Dep. Exhibits 6, 7, 8).

Consumers are able to buy the cancelled cards that were once in play at a casino as a souvenir or as a novelty item. (Espenscheid at 13; Bagger at 20; Index 631). As noted, websites also exist which feature the sale of cancelled playing cards. (Przywara at 11-16 and Przywara Dep. Exhibit 6, 7, 8). Cancelled cards may also be purchased in casino gift shops and stores like the Gambler's General Store in Las Vegas, Nevada. (Przywara at 11-16 and Przywara Dep. Exhibit 6; Espenscheid at 38-39).

### **ARGUMENT**

United States Playing Card has offered considerable evidence that satisfies the three prong test to determine whether a mark is primarily geographically deceptively misdescriptive. In re California Innovations Inc., 66 U.S.P.Q.2d 1853 (Fed. Cir. 2003). The test, which was necessary due to changes in U.S. trademark law after the enactment of NAFTA, the North American Free Trade Agreement, provides that a trademark may not be federally registered if:

(1) the primary significance of the mark is a generally known geographic location, (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place, and (3) the misrepresentation was a material factor in the consumer's decision.

Id. at 1858.

USPC has offered overwhelming evidence proving that the primary significance of Vegas is a generally known geographic location: Las Vegas, Nevada. The Convention and

Visitor's Bureau of Las Vegas, Nevada uses the term Vegas to refer to their city. The *Merriam Webster Geographic Dictionary* lists as its entry for Vegas a reference to the city of Las Vegas, Nevada. Hundreds of articles from periodicals use Vegas in a way that refers to the specific location of Las Vegas, Nevada. There is no escaping the fact that the primary significance of the mark VEGAS is that of a generally known geographic location.

Further, the consuming public is likely to believe that playing cards come from Vegas because of a strong goods-place association between playing cards and the city. Las Vegas is home to some of the nation's largest and most popular casinos. These casinos use playing cards in their games of chance. Additionally, the championships of the World Poker Tour and the World Series of Poker are held annually in Las Vegas and broadcast from Las Vegas on television throughout the country. (Espenscheid at 19-21; Index at 15, 624). Because the relevant public is likely to associate playing cards with gambling, and gambling with Las Vegas, the goods-place association is strong. Therefore, the purchasing public is likely to believe that the playing cards identified by a mark VEGAS are likely to be from Las Vegas.

Finally, the misrepresentation of applicant's goods as being from Vegas is likely to be material to the purchaser's decision. When a goods-place association is strong, the board may presume that a consumer will want goods from the geographical region known for the product. Moreover, the strong market and demand for cancelled casino cards demonstrates that the geographical location of where a playing card is from or used affect the consumer's purchasing decision.

For these reasons VEGAS is primarily geographically deceptively misdescriptive and should not be registered.

**A. VEGAS is short for "Las Vegas," one of the best known geographic locations in the United States.**

The evidence supporting the first element, the primary significance of the mark is a generally known geographic location, consists of dictionary definitions, **over 620** publications which refer to Vegas as a geographic location, and testimony by the Las Vegas Visitor's Bureau which uses VEGAS in advertisements to refer to its city. The scant evidence submitted by Applicant does nothing to contradict the fact that VEGAS is short for "Las Vegas" and refers to a well known, even perhaps one of the best known, geographic locations in the United States.

**1. The Geographic Significance of VEGAS is illustrated by a Dictionary Entry**

The Third Edition of *Merriam-Webster's Geographical Dictionary* lists an entry for Vegas: "See Las Vegas 1." Las Vegas is defined as:

"1. often shortened to Vegas. City of Clark Co., SE corner of Nevada, 22 miles NW of Boulder Dam; pop.(1990c) 258,295; alt. 2030 ft.; distribution center for mining and stock-raising region; major tourist resort featuring legalizes gaming and glitzy hotels..."

Both the entry for Vegas and Las Vegas demonstrate that the terms are synonymous and refer to the largest city in Nevada.

The Board routinely relies on dictionary definitions as evidence of geographic significance. See, e.g., *In re Cotter & Co.*, 228 U.S.P.Q. 202, 204 (TTAB 1985); *In re Broyhill Furniture Industries Inc.*, 60 U.S.P.Q.2d 1511 (TTAB 2001) (Relying on *Cassel's Italian Dictionary* and *Merriam-Webster's Geographical Dictionary*, the Board found the



term "Toscana" (or "Tuscany," in English) designated a region in Italy and had no other meaning.)<sup>4</sup>

The dictionary definition here confirms that Vegas is synonymous with Las Vegas: a generally known geographic location.

**2. The Geographic Significance of VEGAS is illustrated by Widespread Use of the Word to refer to the city of Las Vegas, Nevada**

Opposer, USPC, also submits numerous newspaper and magazine articles as well as television transcripts which illustrate how Vegas is commonly used to refer to the city of Las Vegas, Nevada. Entertainment Weekly, as shown in Index Numbers 5 and 6, refers to Vegas as a geographical place twice in the same June 3, 2005, edition: first as the location of events of the movie GO, directed by Doug Liman, and then as the location of Angelina Jolie's wedding to Billy Bob Thornton. "Vegas" was used in the same six-day period in May, from the 26<sup>th</sup> through the 31<sup>st</sup>, to refer to the geographic location of Las Vegas, Nevada, by the following well known and widely circulated publications: *The Associated Press* (Index 17), *Baltimore Sun* (Index 26), *Fortune Magazine* (Index 28), *Philadelphia Inquirer* (Index 33, 61, 73), *Chicago Tribune* (Index 36), *Detroit Free Press* (Index 37), *San Francisco Chronicle* (Index 44), *Washington Post* (Index 50, 91), *Sacramento Bee* (Index 63), *Orlando Sentinel* (Index 87), and even the *Las Vegas Review-Journal* (Index 82, 83). The 641 publications that comprise the Opposer's Notice of Reliance are referred to herein

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<sup>4</sup> The Board has also relied on dictionaries in recent decisions which were marked as NOT CITABLE AS PRECEDENT OF THE TTAB. Opposer references the following decisions as illustrative: In re Cotchett, Serial No. 78/280591 (TTAB August 5, 2005) (Exhibit B) ( Board relied heavily on definitions for "Half Moon Bay" contained in the *Columbia Gazetteer of North America* and *Merriam-Webster's Geographical Dictionary*.); In re Bristol-Myers Squibb Co., Serial No. 78/222332 (TTAB July 15, 2005) (Exhibit C) (Board relied on the *American Heritage Dictionary of English Language* definition of "Princeton" as a borough in New Jersey and the seat of Princeton University and held that the reference to location of or seat of Princeton University enhanced the term's geographic significance.); In re American International Group, Inc., Serial No. 75/278430 (TTAB June 25, 2002) (Exhibit D) (Board relied, in part, on Examining Attorney's submission of the dictionary definition of "New Hampshire" which referred to its nickname as the "Granite State," as evidence that it was a geographic location.)

by Index numbers; the articles are reproduced in their entirety and listed by Index number in the Notice of Filing.

Articles reproduced from NEXIS, like the ones submitted by USPC, operate as evidence of a mark's primary significance as a generally known geographic location. The Board has relied on such evidence in the following unreported case, not citable as precedent. See, e.g., In re Fashion Group, Serial No. 76/006037 (TTAB Dec. 3, 2004) (Exhibit E) (Board found mark's primary significance as a generally known geographic location based upon dozens of NEXIS article excerpts that showed "NoLita" to be a particular place and a term derived from the phrase "North Little Italy" or "North of Little Italy.").

The Lexis and Westlaw articles submitted in this case show widespread use of the term Vegas to refer to the geographic location of Las Vegas, Nevada. Therefore, the primary significance of VEGAS is that of a geographic location.

**3. The Las Vegas Convention and Visitors' Authority advertised and used "Vegas" alone to identify the city**

Kevin Bagger, Director of Research of the Las Vegas Convention and Visitors' Authority (LVCVA) testified to the significance of Vegas as a geographic location. The LVCVA uses the marks "Only VEGAS" and "Whatever happens in Vegas, stays in Vegas" to promote tourism in the city of Las Vegas. (Bagger at 10). The LVCVA sends tourist information with the "Only VEGAS" design featured prominently on the cover. (Bagger Dep. Exhibits 27, 28).

The LVCVA has an annual advertising budget of 75 to 80 million dollars. (Bagger at 10). Expenditures on behalf of the City which refer to the location as "Only VEGAS" reach across the country. Thus, it is only natural that the City of Las Vegas has two names:

Vegas and Las Vegas, due in some respects to the efforts of the LVCVA to promote the shorter catchier "Vegas" as synonymous with the geographic area.

Mr. Bagger, a long-time resident of Las Vegas, Nevada, testified that through endless tourism promotion, the city is known by two names:

Q: Other than Las Vegas is there -- is the city known by any other term?

A: Well, we -- in our marketing campaign one of the current logos we use is "Only Vegas." That ties in to our "What happens in Vegas stays here" advertising campaign, **but it's also known as Vegas as well as Las Vegas.**

Q: And how do you know that?

A: Personal experience, living in Las Vegas for 35 years, traveling, media accounts.

(Bagger at 10.)

Thus, the evidence demonstrates the primary significance of Vegas is that of a geographical location.

**4. According to the Overwhelming Evidence presented to this Board, the Primary Significance of VEGAS is that of a Geographic Location**

Applicant has not produced evidence to contradict the *primary significance* of the term as a geographic location. However, even if a city is also known for an activity that goes on in the city, the Board has still held that the geographic relevance takes precedence.<sup>5</sup> The Board has consistently recognized the geographic connotation of the mark to be the primary significance of the mark to a consumer in geographic misdescriptiveness cases even when other possible concepts may be conveyed by the

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<sup>5</sup> See, e.g., the following cases, marked as not citable precedent of the TTAB. McCutchin v. DuBell, Opposition No. 91156821 (July 27, 2005)("In order for a term to be *primarily* geographically descriptive, the term does not have to be 'solely geographic' as applicant suggests.") (Exhibit F). The Board has held that the term Princeton, which arguably symbolizes prestigious academic achievement rather than a town in New Jersey, was nevertheless primarily significant as a geographic location. In re Bristol-Myers Squibb Co., Serial No. 78/222332 (July 15, 2005)(Board relied on the dictionary definition of "Princeton" as a borough in New Jersey and the seat of Princeton University and held that the references to location of or seat of Princeton University enhanced its geographic significance.) (Exhibit C). In re BJIP, Inc., Serial No. 75/529080 (July 18, 2001)(The Board recognized that Cuba or Havana-style furniture was popular but that fact did not contradict the primary significance of the term "Havana" as a geographic source of the style and added to the fact that purchasers would associate the goods with that location.) (Exhibit G).

mark. In re California Innovations Inc., 66 U.S.P.Q. 2d 1853 (Fed. Cir. 2003) ("Although the mark [CALIFORNIA INNOVATIONS] may also convey the idea of a creative, laid-back lifestyle or mindset, the Board properly recognized that such an association does not contradict the primary geographic significance of the mark.").

The Board has consistently held that the primacy of a term's geographic significance outweighs all other possible connotations. In In re Bacardi & Co. Ltd., 48 U.S.P.Q. 2d 1031 (TTAB 1998) the Board stated that "even if applicant had established an association between HAVANA and a particular lifestyle of the term, as the association may be made precisely because of the primary significance of HAVANA as a city in Cuba." Similarly, the Board wrote in In re Opryland USA Inc., 1 U.S.P.Q.2d 1409 (TTAB 1986) that "[b]ecause a term [such as Nashville] may have other meanings does not necessarily alter the primacy of its geographical significance."

The dictionary definitions, newspaper and magazine articles, and testimony from a representative of the Las Vegas Convention and Visitor's Authority all demonstrate that the primary significance of Vegas is a well known geographic location. Thus, Opposer has satisfied the first prong of the California Innovations test.

**B. Consumers are likely to believe that Vegas is the origin of Applicant's playing cards because of a well-known association between the goods and the geographic location.**

USPC submitted evidence in its Notices of Reliance including newspaper and magazine articles and the testimony of Kevin Bagger and Dan Espenscheid to demonstrate that card playing and playing cards are associated with Vegas. Thus, USPC has proven the second element of the California Innovations test, generally referred to as the requirement of a goods-place association.

In In re Hiromichi Wada, 52 U.S.P.Q.2d 1539, 194 F.3d 1297 (Fed. Cir. 1999), the term NEW YORK WAYS GALLERY when applied to various kinds of leather bags, luggage, back packs, wallets, tote bags and the like was determined to be primarily geographically deceptively misdescriptive. The record in that case contained NEXIS excerpts showing various leather goods and handbag manufacturers located in New York supported a goods-place association between New York City and leather goods.

The excerpts USPC relies upon in this case show that the public associates Vegas with playing cards and card playing, including poker, black jack and other games. The following list of media excerpts were submitted with the Original Notice of Reliance and demonstrate a goods-place connection:

Index	Publication	Date	Use
624	<i>Boston Herald</i>	July 14, 2005	It's in the cards; Poker craze in spotlight as World Series explodes in glitzy Vegas
625.	<i>Argus Leader</i> (Sioux Falls, ND)	January 13, 2005	It's a best effort to avoid the type of disappointment Nevada officials felt last October. The U.S. mint prohibited use of gambling images, barring slot machines, playing cards..
626.	<i>USA Today</i>	July 6, 2005	Then there's fabulous Las Vegas, including oversized playing cards and dice
627.	<i>Boston Globe</i>	July 14, 2005	For Poker Players, Universal Draw of World Series Lies in Riches Thousands in Vegas Vie for \$7.5 M Prize
628.	<i>Associated Press Wire Report, as published on MSNBC.com</i>	Oct. 2, 2004 at 6:14 pm	Slot machines, playing cards, and even the games Las Vegas skyline won't be on Nevada's quarter
629.	<i>Philadelphia Enquirer</i>	July 5, 2005	In Vegas, they're playing cards
630.	<i>Baltimore Sun</i>	November 2, 2003	A Marylander sells the family business and moves to Vegas to play poker

631.	<i>Chicago Daily Herald</i>	May 27, 2005	Las Vegas playing cards from casinos like the Dunes Hotel
632.	<i>M2 Presswire</i>	June 8, 2005	Gaming Partners International Corporation.. is headquartered in Las Vegas, Nevada

The *Philadelphia Inquirer* article (Index 629) entitled "A Big Pot Adds to Poker's Allure" starts off with the sentence "In Vegas, they're playing cards, and the person who emerges from a field of more than 6,000 people to win this year's main event at the World Series of Poker is going to go home with something like 10 million." The article demonstrates the allure and high prize money available for card playing in Las Vegas, and demonstrates that Vegas is known for famous poker tournaments such as the World Series of Poker. The connection between poker and Las Vegas is also apparent in the *Baltimore Sun's* article entitled "Moving from suburban Maryland to Las Vegas to make a living playing poker? You bet your life." (Index 628).

In fact Las Vegas is so well known for playing cards that Nevada state officials considered putting the image of playing cards on the back of the state's commemorative quarter, before they were overruled by the Federal Treasury Department. See, "No Gambling Images on Nevada Quarter," msnbc.com AP wire (Index 628).

A USA Today article published on July 6, 2005, even mentions that you can have a funeral from a business called Palm Mortuary in Las Vegas. The Las Vegas funeral includes "oversized playing cards and dice." (Index 626). The fact that a Las Vegas funeral would include such iconography as oversized playing cards speaks volumes on the goods place association between the city and a deck of playing cards.

Even connections between a city and goods that are tenuous, unlike the connection USPC has shown here, have been held to be sufficient by the Board to satisfy the goods-

place association test in a geographic misdescriptiveness analysis. For instance, In re Save Venice New York, Inc., 59 U.S.P.Q.2d 1778, 259 F.3d 1346 (Fed. Cir. 2001), involved whether a New York not-for-profit corporation devoted to preserving and restoring cultural treasures of Venice, Italy, could register "The Venice Collection" with respect to potpourri, tableware made of precious and nonprecious metals, lamps, clocks, art prints, paper products, residential furniture, dinnerware, glassware, bedding and carpets. With the exception of some glass products, none of the goods originated in Venice. Nevertheless, the Court found that consumers were likely to be deceived even though the goods were only ***related to*** the types of goods manufactured and sold in Venice, Italy.

The following two cases which have been deemed as not citable by the Trademark Trial and Appeal Board are illustrative of other goods place associations. In In re Fashion Group S. N. C., Serial No. 76/006037 (TTAB December 3, 2004) (Exhibit E), the applicant sought to register "No-l-ita" and "NORTH LITTLE ITALY" for a wide variety of clothing. The Board found a goods-place association because the marks referred to a neighborhood of Manhattan in New York noted for trend-setting fashions.

In In re Bristol-Myers Squibb Co., Serial No. 78/222332 (TTAB July 15, 2005) (Exhibit C), the Board found that the fact that applicant had a research facility in Princeton, New Jersey supported a goods-place association between pharmaceutical products and Princeton. USPC has submitted an article (Index 632) which shows the presence of a card manufacturer, Gaming Partners International Corp., in Las Vegas, Nevada. Further, there is evidence in the record that USPC maintains a warehouse in Las Vegas for its casino business. (Espencheid at 7).

USPC has also presented testimony of Dan Espenscheid and of Kevin Bagger on the goods place association between Vegas and playing cards. Bagger, the director of research at the LVCVA, testified that Las Vegas is known for its gaming, which includes legal games of chance like slot machines, blackjack, craps and roulette. (Bagger at 9). These games, such as black jack, involve the use of playing cards. (Bagger at 10). Dan Espenscheid, Director of Casino Sales for USPC testified that there are many well-known large casinos in Las Vegas, Nevada. (Espenscheid at 11). The casinos need a replenishable supply of playing cards in order to conduct games of chance such as black jack. (*Id.* at 12). USPC and other card companies including Gemaco and GPI supply the playing cards to the casinos. (*Id.* at 13). This testimony demonstrates that Las Vegas casinos and establishments use playing cards daily in large amounts.

While USPC believes that a goods place association has been demonstrated, the board has found a goods place association even when a geographic location is not primarily known for the goods involved. In re Broyhill Furniture Industries Inc., 60 U.S.P.Q.2d 1511 (TTAB 2001), involved a North Carolina furniture corporation's effort to register "Toscana" for furniture. The registration was refused on grounds that "Toscana" (or Tuscany, in English) was primarily geographically deceptively misdescriptive. The Board found the term designated a region in Italy. The Examining Attorney produced evidence including only three Lexis/Nexis articles and several printouts from websites that referred to Tuscan furniture as well as copies of online ads for villa and apartment rentals in Tuscany that referred to Tuscan furniture. However, the Board held that the evidence produced by the Examining Attorney was sufficient to make a *prima facie* showing that there was a reasonable basis for concluding the public is likely to believe that the mark



identifies the place from which the goods originate and that the applicant's evidence was insufficient to rebut this showing. Relying, in part, on In re Save Venice, the Board concluded that:

Clearly, furniture is a product which is made in Tuscany, as it is in numerous geographic locales throughout the world, and members of the general public interest in purchasing furniture which comes from Tuscany would, during the course of an Internet search, find advertisements of the kind which have been made of record. The evidence is sufficient to establish a *prima facie* showing that the purchasing public would reasonably believe that furniture bearing the mark "TOSCANA" is manufactured or otherwise originates in Tuscany and applicant has offered nothing to rebut the goods/place association which consumers would be likely to make.

\* \* \* \*

In particular, Tuscany has been shown to be a sizeable region which produces a wide variety of products, including furniture. While Tuscany is apparently not famous or otherwise noted for its furniture, such is not a requirement in order for consumers to mistakenly believe that a goods/place association exists . . . According to the record, Tuscany is an important industrial center and, especially in the case of pieces of handcrafted furniture (which are products encompassed by the goods identified in applicant's application, such items plainly would be considered by consumers to be a natural expansion of Tuscan's longstanding handicraft industries, particularly those in wood and metal.

60 U.S.P.Q. 2d 1511, 1518.

While playing cards are obviously used in casinos and in houses throughout the country, the use of playing cards in Las Vegas has intertwined the iconography of the City of Las Vegas with playing cards and their insignia: hearts, diamonds, clubs and spades. (See Przywara Dep. Exhibits 4 and 5). Similarly, the fact that furniture is made in locales around the world other than Tuscany did not preclude the Board from finding a heightened goods place association between Tuscany and furniture. Thus, it is not relevant that other casinos exist in the United States that also use playing cards; the relevant question remains whether a goods-place association exist between the geographic location at issue and the goods for which trademark protection is sought.

The evidence presented in this case shows a clear association between Las Vegas and playing cards. Gambling and poker are alive and thriving in Las Vegas, and concomitantly, use and sale of playing cards is thriving in Las Vegas. USPC has shown through testimony and substantial documentary evidence that playing cards have a heightened association with the geographic location of Vegas.

**C. Applicant's misrepresentation that its playing cards are associated with "Vegas" would materially affect the public's decision to purchase the goods.**

The fact that playing cards are connected with or are used in Vegas is material to a consumer's purchasing decision. USPC has offered evidence which demonstrates a competitive market for cancelled casino cards which were used in many Las Vegas casinos. Further, recent case law authorizes the Board to assume that the geographical misrepresentation plays a material part in the decision to buy VEGAS playing cards when the goods-place association is heightened. Thus, USPC has satisfied the third prong of the California Innovations test and the VEGAS mark should be refused registration.

In the Colorado Steakhouse case, this Board found that "an inference of materiality arises where there is a showing of a 'heightened association' between the [goods] and the geographic place." In re Consolidated Specialty Restaurants, 71 U.S.P.Q.2d 1921, 1928 (TTAB 2004). USPC has submitted testimony and articles submitted via Notice of Reliance which proves that there is a heightened association between playing cards and Las Vegas, Nevada.

Furthermore, the existence of a robust market for cancelled casino cards from Vegas demonstrates that consumers are interested in obtaining cards that have an origin or associated with Las Vegas. Playing cards that are used in a casino for table games are cancelled before being offered sold to the public. The cancellation involves a small

physical alteration of the cards. (Bagger at 20). Cards are cancelled so that people can not bring them back into the casino to cheat at the card games, which is why cancelled cards are designed to be easily distinguishable from cards that are still in play. (Bagger at 20).

Casino gift shops, located on-site at several Vegas casinos, sell their cancelled casino cards to those wishing to buy a deck of cards that was actually used on the Vegas casino tables. (Bagger at 19-20). Cancelled cards from Vegas casinos are also sold to the public at The Gambler's General Store. (Espenscheid at 39). The internet is also a popular marketplace for cancelled casino cards from Las Vegas. Ms. Przywara testified that she printed information from numerous websites demonstrating a market for such cards. (Przywara at 11-16).

Cards that are associated with Las Vegas add an authenticity and cultural cachet to the playing cards. This desire for authenticity is demonstrated in a New York Times article that invites people throwing a poker night gathering to make the mood seem more authentic. "With the right accouterments, like a Montecristo in one hand and a glass of whiskey in the other, you can pretend you're among the new breed of young card sharks racking up big wins in Las Vegas." (Index at 637). One way to achieve such a feeling is to "deal from a deck of used playing cards from Las Vegas casinos that frequently replace their cards." (Id.)

If consumers believe that the playing cards originated or were associated with Las Vegas such knowledge may materially affect their decision whether to purchase the VEGAS playing cards. The evidence USPC has offered as to the market for cancelled casino cards from Vegas demonstrates that association of the cards with Las Vegas can be a material factor in a consumer's decision.

Even without such evidence, the goods-place association between Las Vegas and playing cards is so strong that the Board may presume that the geographical connection between the place and the goods led to the consumer's decision to purchase the goods. In In re Hiromichi Wada, 52 U.S.P.Q. 2d 1539, 1540-41, 194 F.3d 1297, 1299-1300 (Fed. Cir. 1999), evidence presented showed that New York was well-known as a place where leather goods were designed and manufactured and upon encountering the goods bearing the proposed mark, consumers would believe that the goods originated in New York, "a world-renowned fashion center ... well-known as a place where goods of this kind are designed, manufactured, or sold."

Therefore, the Board reasoned that a strong goods-place association means that it was correct to infer that consumers would use the geographic information in a product's name in a material way.<sup>6</sup> In California Innovations, the Board wrote that "if there is evidence that goods like applicant's or goods related to applicant's are a principal product of the geographical area named by the mark, then the deception will most likely be found material and the mark, therefore, deceptive." 66 U.S.P.Q. 2d at 1857-58, citing, In re House of Windsor, Inc., 221 U.S.P.Q. 53, 57 (TTAB 1983). Furthermore, "if [a] place is noted for the particular goods, a mark for such goods which do not originate there is likely to be deceptive under §2(a) and not registerable under any circumstances." Id., citing, In re Loew's Theatres, 226 U.S.P.Q. 865, 868 n.6, 769 F.2d 764, 768 n.6 (Fed. Cir. 1985).

The evidence shows that an inference of materiality is appropriate in this case. USPC has demonstrated through the existence of a market for cancelled casino cards from

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<sup>6</sup> Similarly, in a decision marked as "not citable as precedent," the Board held that it would materially affect a purchase maker's decision that Zhiguly Beer came from a region of Russia known for its beer. Donya, Ltd. v. Donya Michigan Co., Cancellation No. 92033012 (TTAB Sept. 6, 2005) (Exhibit G).

Vegas that an association between the cards and Las Vegas is a material factor in a consumer's purchase decision. Having satisfied the third prong of the California Innovations' test, USPC submits the Board should refuse registration of Applicant's VEGAS application.

**V. Conclusion**

Opposer respectfully requests that Application number 78/253725 be refused registration based on 15 USC §1052 (c)(3) which bars the registration of geographically deceptively misdescriptive trademarks such as VEGAS. USPC has conclusively demonstrated through testimony and exhibits that Vegas is a well known geographic location from which Opposer's product does not originate, that playing cards have a strong goods-place association with the geographic location and that such an association is material to a potential purchaser of Applicant's goods. Accordingly, the Board should sustain the opposition and refuse registration.

Dated: **March 13, 2006**



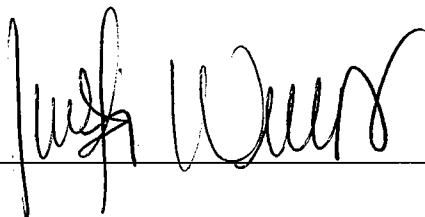
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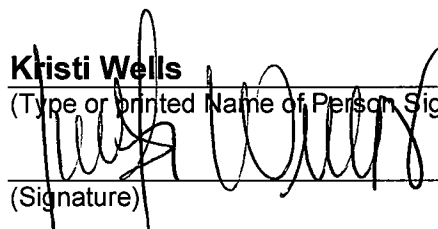
**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a copy of the foregoing was sent by e-mail and U.S. Mail on this 13<sup>th</sup> day of March, 2006 to Timothy A. Flory, Van Dyke, Gardner, Linn & Burkhart, LLP, 2851 Charlevoix Drive, S.E., P.O. Box 888695, Grand Rapids, MI 49588-8695.

  
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**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office on the date shown below.

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**March 13, 2006**  
\_\_\_\_\_  
(Date)